

REMARKS/ARGUMENTS

Claims 1 and 4-20 are pending. Claims 2 and 3 are canceled without prejudice.

Claim 1 is currently amended to incorporate the subject matter of previously presented claim 2. Claims 16-18 are added and find support in original claim 1. Claims 19 and 20 are added and find support in the Examples (pgs 16-19). No new matter has been entered.

With respect to the 35 U.S.C. §102(b) rejection, Applicants submit that *Haeberle* does not anticipate the present claims. The Office asserts that “given applicants’ breadth of ranges within claim 2, the position is taken that one would have immediately envisioned component amounts of the blend, such as 50:50 mixtures, that meet the claimed ratios” (page 3, lines 9-11). However, Applicants’ assert that the Office’s position is mistaken. First, 50:50 mixtures as suggested by the Office are not within the claimed ratios because the claimed mixture comprises 3 elements, the last of which (C) is required to be present in an amount of 5-40% by weight.

Second, one cannot at once envisage the weight % ranges of Applicants’ claim 1 from *Haeberle*’s disclosure. M.P.E.P. 2131.02 states:

If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962).

Haeberle does not disclose weight % ranges that can be equated to a “generic chemical formula”. In fact, *Haeberle* only discloses specific masses of (A)-like and (B)-like compounds in the Examples. Accordingly, one can calculate a weight % for the components of each Example and create a weight % range; however this results in 83-90 weight % of (A)-like components and 1.4-3.7 weight % of (B)-like components. These calculated weight %

ranges do not render the claimed ranges of 30-90% by weight of (A) and 5-60% by weight of (B) “at once envisaged”. Furthermore, *In re Petering* stands for the notion that specific compounds included in a generic formula are capable of being at once envisaged. Applying a similar rationale, Applicants’ claimed weight % range of (B) is not within *Haeberle*’s calculated weight % range of (B)-like compounds. Therefore, Applicants’ weight % ranges cannot be considered “at once envisaged” from *Haeberle*’s disclosure. Thus, *Haeberle* can not be considered anticipatory of Applicants’ amended claim 1 that incorporates said weight % ranges.

Third, *Haeberle* does not disclose Applicants’ weight % ranges with “sufficient specificity” to be considered anticipatory. M.P.E.P. 2131.03(II) states:

“In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, and the reference teaches a broad range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims.”

As stated above, *Haeberle* teaches only those weight % values that can be calculated from the Examples: 83-90 weight % of (A)-like components and 1.4-3.7 weight % of (B)-like components. For instance, when one considers the (B)-like components, 1.4-3.7 weight % as taught by *Haeberle* is not a “broad range” that discloses the claimed range of 5-60 weight % with “sufficient specificity to constitute an anticipation of the claims”. Thus, *Haeberle* can not be considered anticipatory of Applicants’ amended claim 1 that incorporates the weight % ranges.

Lastly, the disclosure of *Haeberle* does not render obvious Applicants’ claim 1 as amended. Examples 8 and 9 of *Haeberle* (col. 7) are the closest examples to Applicants’

claims, and even then they fall outside of the claimed weight % parameters of Applicants' claims. For example, the (B)-like components are present in amounts of 2.3 and 3.0 weight % respectively, which is well below the 5 weight % minimum threshold of the claimed 5-60 weight % required by Applicants. Even further, the only teaching of *Haeberle* that lies within Applicants' claimed range is Comparative Examples 1 and 2 that are both disparaged for multiple reasons. Therefore, one skilled in the art would not have found it obvious to modify the weight % range of the (B)-like components to be as high as 5.1-5.2 weight % as found in the Comparative Examples, and surely one would not have found it obvious to modify the weight % range to a value as high as 60% as claimed by Applicants.

With respect to the 35 U.S.C. §103(a) rejection, Applicants submit that *Morikawa* does not fulfill what is lacking from *Haeberle's* disclosure. The Office asserts that "amounts of the respective isocyanurates are disclosed that significantly overlap those of claim 2" (pg 4, last sentence); however this is not correct. *Morikawa* teaches an isocyanate mixture of (a) modified-HDI and (b) modified-IPDI, wherein the mixture (i.e. (a)+(b)) is in a proportion of 0-30% by weight (col. 2, lines 16-47). On the contrary, Applicants claim 30-90% by weight of (A) isocyanurate of HDI, and 5-60% by weight of (B) isocyanurate of IPDI. Therefore, the minimum proportion of a mixture of (A) and (B) is 35% by weight, which is more than the upper limit of *Morikawa*. Thus, *Morikawa* does not remedy the weight % range deficiency of *Haeberle*.

Moreover, *Morikawa's* mixture of (a) and (b) can be 0% by weight (see above), which results in the modified-IPDI being 0% by weight. Applicants' specification teaches that when the isocyanurate of IPDI is 0% by weight, an undesirable softer paint film is obtained, as can be seen by the lower number of pendulum swings of Comparative Example C as compared to the Examples on page 18 (reproduced below):

Example No. 1	Isocyanate a1	Isocyanate B	PC	NCO content
	(g)	(g)	(g)	(%)
1	28	5	22	10.9
2	24.5	7.5	21.33	10.8
3	21	10	20.67	10.8
4	17.5	12.5	20	10.7
Comparative, C	30	./.	20	11.0

Results: example 1

	Pendulum damping				
Baking temp. [°C]	1	2	3	4	V
60	44	41	43	52	26
70	67	68	64	74	36
80	93	87	107	105	42
90	98	108	122	124	45
100	121	126	126	136	47
110	125	128	130	138	53
120	126	131	131	140	94
130	126	132	132	141	99
140	126	132	136	141	99
150	130	132	138	141	101

(Please note that "V" is supposed to read "C" under pendulum damping).

Thus, the criticality of Applicants ranges can be seen and the range of *Morikawa* does not render obvious Applicants' ranges. Accordingly, neither *Haeberle*, nor *Morikawa*, nor the combination of the two renders obvious Applicants' claims.

Claims 4-20 are either directly or indirectly dependent on and include all the limitations of claim 1, which as currently amended is in allowable form, therefore claims 4-20 are also in condition for allowance.

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

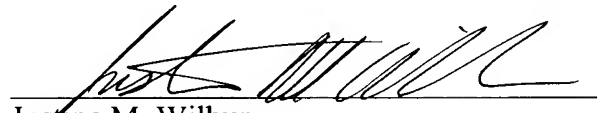
Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Justine M. Wilbur', is written over a horizontal line.

Justine M. Wilbur
Registration No. 59,678